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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,424

12/05/2003

Michael J. O'Phelan

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10/04/2004

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EXAMINER

THOMAS, ERIC W

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,424

Applicant(s)

O'PHELAN ET AL.

Examiner

Eric W Thomas

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/04, 8/04, 9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

INTRODUCTION

The examiner acknowledges, as recommended in the MPEP, the applicant's submission of the amendment dated 8/16/04. At this point, claims 1-39 have been cancelled; and claims 40-60 have been added. Thus claims 40-60 are pending in the instant application.

Election/Restrictions

The election/restriction requirement has been withdrawn in view of the amendment filed 8/16/04.

Specification

1. The disclosure is objected to because of the following informalities:

Applicant is required to update the priority information found on page 1 of the specification.

Applicant is required to update the cited documents found on page 7 and 8 of the specification.

Appropriate correction is required.

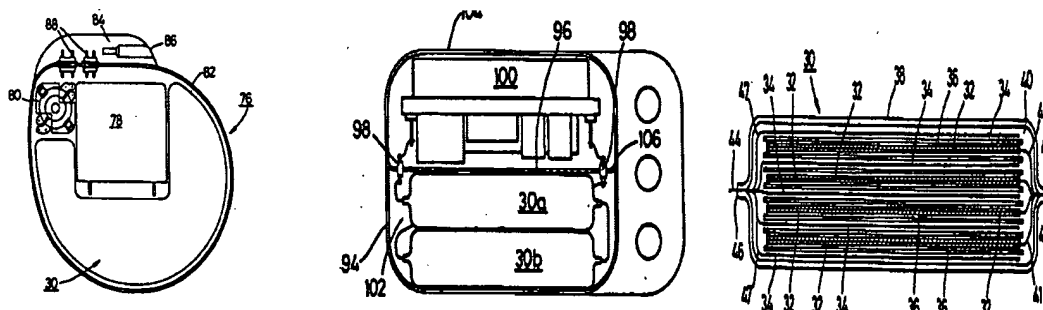
Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 40-42, 45-46, 48-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Pless et al. (US 5,131,388).



Pless et al. disclose in fig. 2, 4, & 5, an assembly for implantable medical devices, the assembly comprising: a first generally U-shaped capacitor (30a) having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions oriented in a common direction relative the middle portion and spaced apart to define a first open region; a second generally U-shaped capacitor (30b) placed adjacent the first U-shaped capacitor, the second U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions with the middle portion of the second capacitor adjacent the middle portion of the first capacitor and the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region; a medical-device component (78) positioned at least partly within the first and second open regions.

Regarding claim 41, Pless et al. disclose the medical-device component includes a battery (col. 4 lines 50-55).

Regarding claim 42, Pless et al. disclose the device is an implantable medical device (see col. 1 lines 10-20).

Regarding claim 45, Pless et al. disclose an assembly comprising: a first generally U-shaped capacitor (30a) including a first capacitor case (38) having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions spaced apart to define a first open region, the first capacitor case having a first case wall; and a second generally U-shaped capacitor (30b) including a second capacitor case (38) placed adjacent the first capacitor case, the second capacitor case having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region, the second case having a second case wall confronting the first case wall.

Regarding claim 46, Pless et al. disclose the first capacitor includes a first pair of terminals (42, 44) and the second capacitor includes a second pair of terminals (42, 44), wherein at least one of the second pair of terminals is coupled to at least one of the first pair of terminals (see fig. 5).

Regarding claim 48, Pless et al. disclose a medical-device component positioned at least partially (78) within the first and second open regions.

Regarding claim 49, Pless et al. disclose the first and second open regions are adjacent each other.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 43-44 and 50 rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al. (US 5,131,388) in view of Elias et al. (US 5,926,357).

Regarding claims 43, and 50, Pless et al. discloses the first and second capacitors are located in a first and second polymer case. Pless et al. disclose the claimed invention except the first and second conductive cases are conductive.

Elias et al. teach that it is known in the art to form a capacitor housing form a conductive housing (see col. 2 line 35).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the capacitors of Pless et al., using conductive (metallic) casings of Elias et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 44, Pless et al. disclose the first case has a curved interior surface and the second case includes a curved interior surface.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 40-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,522,525. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 40, '525 discloses an assembly for implantable medical devices, the assembly comprising: a first generally U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions oriented in a common direction relative the middle portion and spaced apart to define a first open region; a second generally U-shaped capacitor placed adjacent the first U-shaped capacitor, the second U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg

portions, with the middle portion of the second capacitor adjacent the middle portion of the first capacitor and the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region; a medical-device component positioned at least partly within the first and second open regions.

Regarding claim 41, '525 discloses the medical-device component includes a battery.

Regarding claim 42, '525 discloses the implantable medical device comprising the assembly of claim 40.

9. Claims 43-49, 51-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, and 22 of U.S. Patent No. 6,522,525 in view of Pless et al (US 5,131,388).

Regarding claims 43, '525 discloses the claimed invention except for the first capacitor is located within a first conductive case and the second capacitor is formed in a second conductive case.

Pless et al. teach that it is known in the art to form a casing around a first and second capacitor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify '525 by form casings around the first and second capacitors as taught by Pless et al., since such a modification would protect the capacitors.

The modified '525 discloses the claimed invention except for the casings are formed from a conductive material. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the capacitors of '525, using conductive casings, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 44, the modified '525 discloses the first case includes a curved interior surface and the second case includes a curved interior surface.

Regarding claim 45, '525 discloses an assembly comprising: a first generally U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions spaced apart to define a first open region, and a second generally U-shaped capacitor placed adjacent the first capacitor, the second capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region.

'525 discloses the claimed invention except for the first and second capacitors are formed within a first and second casing, wherein the second casing having a second case wall confronting the first case wall.

Pless et al. teach that it is known in the art to form a casing around a first and second capacitor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify '525 by form casings around the first and second capacitors as taught by Pless et al., since such a modification would protect the capacitors.

Regarding claim 46, Pless et al. teach that the first capacitor includes a first pair of terminals (42, 44) and the second capacitor includes a second pair of terminals (42, 44), wherein at least one of the second pair of terminals is coupled to at least one of the first pair of terminals (see fig. 5).

Regarding claim 47, '525 disclose the first capacitor has a first nominal size and the second capacitor has a second nominal size, with the first and second nominal sizes are different.

Regarding claim 48, Pless et al. teach that a medical-device component is positioned at least partially (78) within the first and second open regions.

Regarding claim 49, Pless et al. teach that the first and second open regions are adjacent each other.

Regarding claim 51, '525 discloses an comprising: an assembly comprising a housing having an interior surface; a first capacitor having a first edge face confronting the interior surface; and a second capacitor having a second edge face confronting the interior surface, wherein the second edge face is set back from the first edge face to define a profile generally congruent to a profile of the interior surface.

'525 discloses (claim 1) the claimed invention except for the capacitor is used in a implantable monitor and the first and second capacitors comprise first and second housings.

Implantable monitors are well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use an implantable monitor as the implantable medical device of '634, since such a modification would provide a system for the capacitor to operate.

Pless et al. teach that it is known in the art to form a casing around a first and second capacitor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify '525 by form casings around the first and second capacitors as taught by Pless et al., since such a modification would protect the capacitors.

Regarding claim 52, the modified '525 (as suggested in claim 1) disclose the first case has a first nominal size and the second case has a second nominal size, the second nominal size being different than the first nominal size.

Regarding claim 53, the modified '525 (as suggested in claim 1) disclose the first case has a first nominal length and the second case has a second nominal length that differs from the first nominal length.

Regarding claim 54, the modified '525 (as suggested in claim 1) disclose the first case has a first nominal width and the second case has a first nominal width that is different from the first nominal width.

Regarding claim 55, the modified '525 disclose the first case has a first nominal size and the second case has a second nominal size, the second nominal size being the same as the first nominal size (as modified by Pless et al.).

Regarding claim 56, the modified '525 discloses the first case and second case are adjacent each other.

Regarding claim 57, the modified '525 further comprising a third capacitor including a third case having a third edge face confronting the interior surface.

Regarding claim 58, the modified '525 discloses the third case has a nominal size which differs from the first nominal size of the first case (as suggested in claim 1).

Regarding claim 59, the modified '525 discloses the interior surface of the housing is a curved surface.

Regarding claim 60, the modified '525 discloses the interior surface of the housing includes a curved surface.

Regarding claim 61, the modified '525 discloses (claim 7) the first capacitor includes two or more U-shaped aluminum foils and at least one U-shaped dielectric layer between two of the two or more aluminum foils.

10. Claims 40-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 6, & 11 of U.S. Patent No. 6,674,634 in view of Pless et al. (US 5,131,388).

Regarding claim 40, '634 discloses in claim 1, an assembly for an implantable heart monitor comprising a first and second capacitor.

'634 discloses the claimed invention except for the first capacitor is generally U-shape having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions oriented in a common direction relative the middle portion and spaced apart to define a first open region; a second generally U-shaped capacitor placed adjacent the first U-shaped capacitor, the second having a U-shape having first and second leg portions and a middle portion joining the first and second leg portions with the middle portion of the second capacitor adjacent the middle portion of the first capacitor and the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region; a medical-device component positioned at least partly within the first and second open regions.

Pless et al. teach the use of a first generally U-shaped capacitor (30a) having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions oriented in a common direction relative the middle portion and spaced apart to define a first open region; a second generally U-shaped capacitor (30b) placed adjacent the first U-shaped capacitor, the second U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions with the middle portion of the second capacitor adjacent the middle portion of the first capacitor and the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region; a medical-device component (78) positioned at least partly within the first and second open regions.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify '634 by forming the assembly having a first generally U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions oriented in a common direction relative the middle portion and spaced apart to define a first open region; a second generally U-shaped capacitor placed adjacent the first U-shaped capacitor, the second U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions with the middle portion of the second capacitor adjacent the middle portion of the first capacitor and the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region; a medical-device component positioned at least partly within the first and second open regions, since such a modification would minimize the area needed for passive components within the implantable medical device.

Regarding claim 41, Pless et al. teach that the medical device component is a battery.

Regarding claim 42, '634 discloses the capacitor is for an implantable medical device (claim 1).

Regarding claim 43, '634 discloses the first and second capacitors are located within conductive cases.

Regarding claim 44, '634 discloses (claim 6) the first and second capacitor casings includes a curved interior surface.

Regarding claim 45, '634 discloses (claim 1, 11), an assembly comprising a first capacitor having a first case, and a second capacitor having a second case. The first capacitor is placed adjacent to the second capacitor. '634 discloses the claimed invention except for the first and second capacitors having a U-shape wherein the first casing having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions spaced apart to define a first open region, and the second capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region.

Pless et al. teach the use of a first generally U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions spaced apart to define a first open region, and a second generally U-shaped capacitor placed adjacent the first capacitor, the second capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify '634 by forming the assembly having a first generally U-shaped capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions spaced apart to define a first open region, and a second generally U-shaped capacitor placed adjacent

the first capacitor, the second capacitor having first and second leg portions and a middle portion joining the first and second leg portions, with the first and second leg portions of the second capacitor oriented in the common direction and spaced apart to define a second open region.

Regarding claim 46, '634 discloses (claim 1) the first capacitor includes a first pair of terminals and the second capacitor includes a second pair of terminals, wherein at least one of the second pair of terminals is coupled to at least one of the first pair of terminals.

Regarding claim 47, '634 discloses (claim 1) the first capacitor has a first nominal size and the second capacitor includes a second nominal size, with the second nominal size being different than the first nominal size.

Regarding claim 48, Pless et al. teach that a medical-device component positioned at least partially within the first and second open regions.

Regarding claim 49, Pless et al. teach that the first and second open regions are adjacent each other.

Regarding claim 50, '634 discloses (claim 11) herein the first case and the second case are conductive.

Conclusion

In order to ensure full consideration of any amendments, affidavits, or declaration, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116 which will be strictly enforced.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric W Thomas whose telephone number is 571-272-1985. The examiner can normally be reached on M,Tu,Sat 9 am - 9:30 pm; W, Th, F 6 pm -10:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be "Eric W Thomas", followed by a date stamp "9/28/04".

Eric W Thomas
Examiner
Art Unit 2831

ewt